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Docket Number 03 PAT 191

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicant:	Roy R. Vann	Date:	2 August 2004
Serial Number:	10/656,061	Examiner:	Matthew J. Smith
Filing Date:	5 September 2003	Art Unit:	3672
Title:	Method for Using a Reciprocating Pump Vent-Dump Valve		

RESPONSE TO FIRST OFFICE ACTION AND AMENDMENTS

To the Honorable Commissioner for Patents
Mail Stop Amendment - FEE
P.O. Box 1450
Arlington, Virginia 22313-1450

Sir:

This is the first amendment to the subject application in response to the Office Action mailed on May 24, 2004. A shortened statutory response period of three months was set by the Examiner, making the response due on or before August 24, 2004. The Office granted a Petition to Make Special because of Applicant's age. In light of the petition and the requirements of the Office, Applicant submits his response as quickly as possible; however, a sister divisional application (10/656,084) was submitted on the same date as this application (5 September 2003) and Applicant has been waiting an Office Action on this copending application so that the responses could be filed together.

In response to the Office Action, please amend the above-identified application, without prejudice, as follows:

Summary of the Office Action

As stated above the Petition to make Special was granted and the application was accorded special status entitling the applicant to examination out of turn and an interference search. An interference search was completed on 21 April 2004. No interfering application was discovered.

The Examiner required restriction to one of the following inventions under 35 U.S.C. 121 giving reasons as follows:

- I. Claims 1-6, drawn to spotting chemicals, classified in class 166, subclass 305.1.
- II. Claims 7-10, drawn to clearing sand, classified in class 166, subclass 312.

The Examiner stated that the inventions are distinct each from the other and a restriction is proper.

The Examiner held a telephone conversation with C. W. Alworth, Applicant's Attorney, on 21 April 2004, and a provisional election was made without traverse to prosecute the invention of Group I, claims 1-6. Claims 7-10 were withdrawn from further consideration by the examiner as being drawn to a non-elected invention. The Examiner required affirmation of the election in replying to this Office action.

The Examiner objected to the drawings as failing to comply with 37 CFR 1.83(a) because they do not show every feature of the invention specified in the claims. Namely the wellhead structure with claimed valves must be shown. The Examiner required a proposed drawing correction or corrected drawings in reply to the Office action to avoid abandonment of the application.

The Examiner quoted from the appropriate paragraphs of 35 U.S.C. 103(a) that formed the basis for rejection:

(a) A patent may not be obtained through the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The Examiner rejected Claims 1 and 5 under 35 U.S.C. 103(a) as being unpatentable over Muller et al. (5020592) in view of Langseth et al. (6357525) stating that Muller et al. disclose a method for spotting chemical in production tubing using makeup fluid and a downhole vent-

dump valve. The Examiner added that “Langseth et al. present makeup or kill fluid after spotting chemical (col. 6, lines 53-62), valves 42, 44 for the chemical and kill fluid in question.”

The Examiner objected to Claims 2-4 and 6 as being dependent upon a rejected base claim, but stated that they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Examiner made the prior art of Hartsell (2,562,458) showing a dump valve, Watson (3713490) spotting fluid, and Williamson (4766960) and Allamon et al (6520257) displaying downhole valves of record as being pertinent to applicant's disclosure.

Affirmation of Restriction

Applicant affirms his election of claims 1-6 drawn to spotting chemicals. Applicant retains all rights in the remaining portion of his disclosure namely claims 7-10 drawn to cleaning a well for further application as a division of this application.

Amendments to the Drawings

Amendments to the drawings are required. Applicant submits amended drawing Figure 1 showing the wellhead and valves of the claims. Support for this amendment may be found in the claims themselves and in the preamble to claim 1 as originally filed. The amendments do not add new material as wellhead and wellhead valves are well known in the industry (prior art) and serve only to clearly point out distinctly claim the subject matter considered to be the invention.